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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: DROOG ET AL.

Serial No: 10/706,797

Examiner: HUYNH, Louis K.

Filed: November 12, 2003 Art Unit: 3721

For: BAG FILLING APPARATUS AND METHOD

BRIEF ON APPEAL

MAIL STOP: APPEAL BRIEF PATENTS
Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 223 13-1450

Dear Sir:

Appellant hereby appeals the Examiner's Final Rejection of claims 48, 49, 51 and 58 and 59 in the Advisory Action dated March 18, 2005.

I. Real Party in Interest

The real party in interest in this appeal is the Applicant Boss Packaging Inc., owner of the rights of the application by virtue of an Assignment signed October 12, 2004 (hereinafter the "Appellant").

II. Related Appeals or Interferences

No related appeals or interferences exist.

III. Status of Claims

Claims 1 to 47, 50, 52 to 57 and 60 have been cancelled. Claims 48, 49, 51, 58 and 59 reside in the application. Claims 48-51 and 58-60 are rejected in a Final Rejection dated October 13, 2004. The claims 48, 49, 51, 58 and 59 were rejected in the Advisory Action dated March 18, 2005. A copy of the Claims are Appendixed hereto. The Appeal for claims 50 and 60 is hereby withdrawn such that only claims 48, 49, 51, 58 and 59 are currently pending.

IV. Status of Amendments

An Amendment under 37 CFR 1.116, filed February 17, 2005, has been entered for purposes of this appeal. The Amendment of August 27, 2004 remains entered.

V. Summary of Invention

Appellant's invention is directed to a bag filling apparatus and method as depicted in Figure 1 of the drawings. The bag filling apparatus includes a bag gripper assembly (see Figures 1 to 4 and 7 of the drawings) for releasably gripping individual bags.

VI. Summary of Issues

The two issues to be addressed by the Honorable Board is whether Appellant is improperly attempting to capture by way of this divisional application subject matter that the Appellant is not allegedly entitled to and whether the Examiner is entitled to determine a priority claim as invalid. The claims of this application have been copied from U.S. Patent No. 6,550,226, Gates et al., for the purposes of an interference. It is the Examiner's position that the Appellant failed to specifically apply each limitation or element of each of the copied to the claim(s) to the disclosure of the application. It is the Examiner's further position that support for the claims are not found in the present application and as such the priority claim is invalid and the later filed application, namely Gates et al. renders the claims of the present invention to be anticipated.

VIII. Argument

The Final Rejection

Claims 48, 49, 51, 58 and 59 are finally rejected under 35 USC 112 as failing to claim subject matter in such a way that any

person skilled in the art to which it pertains can make and use the same to carry out the invention.

In support of the rejection of claims 48-51 and 58-60 , the Examiner states as follows:

"The instant specification and drawings do not disclose and/or teach:

- Providing a pair of finger assemblies and moving the finger assemblies up, over, and down over the top edges of the bag (claims 48);
- Moving the bag toward the sealing apparatus while the finger assemblies are moving away from each other (claims 50 and 60);
- Grasping the opposed top edges of the bag with a pair of grabber arms (claim 48);
- Pulling the grasped top edges of the bag apart (claim 48);
- Moving the finger assemblies away from each other to close the opening of the bag (claims 49 & 59);
- Pulling the grasped edges of the bag apart while delivering the bag to a sealing apparatus (claim 51);
- Grasping the opposed top edges of the bag with a pair of finger assemblies that move inwardly and down to grasp the top edges of the bag (claim 58)."

In further support of the rejection, the Examiner states:

"Because claims 48-51 and 58-60 contains subject matter which was not supported by the instant specification and the originally filed specification of the parent Application No. 09/890,083, they form new matter and thus are not entitled to the filing date of the parent Application No. 09/890,083 or PCT/CA00/001 14 or Canada 2,262,276."

The rejection is without basis.

In support of the rejection of claims 48, 49, 51, 58 and 59, the Examiner states:

"The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
the claimed subject matters contained in the pending claims, which are intentionally copied from U.S. Patent No. 6,550,226 for the purpose of provoking inteference, are not supported in the present application and/or parent applications, they are, therefore, considered to be new matters and are rejected as set forth in the last Office Action.~~

The rejection is also without basis.

Applicable Standard of Review

An interference will not be declared between an application and an unexpired patent unless an Examiner determines that there

is interfering subject matter claimed in the application and the patent 'which is patentable to the applicant subject to a judgement in the interference' 37 CFR 1.606.

The Court in *Aelony v. Arni* stated as follows with respect to the interference:

"A significant function of an interference proceeding is to insure that 'only one patent should issue for one inventive concept.'" *Aelony v. Arni*, 547 F.2d 566, 192 USPQ at 486.

Pursuant to authority granted by 35 U.S.C. § 135, the current interference rules implement the Patent Law

Amendments Act of 1984, Pub. L. No. 98-622, §~ 201-

02. Patent Interference Proceedings, 49 Fed. Reg. 48,416 (Dec. 12, 1984); 37 C.F.R. § 1.601-1.690 (2003). Section 135 of the United States Code, Title 35, governs patent interference proceedings, which are designed to determine whether two patent applications (or a patent application and an issued patent) are drawn to the "same patentable invention" and, if so, which of the competing parties was first to invent the duplicative subject matter. See Conservolite, Inc. v. Widmayer, 21 F.3d 1098, 1100-01

(Fed. Cir. 1994). The statutory basis for declaring an interference proceeding, 35 U.S.C.

§ 135(a), reads in pertinent part:

Whenever an application is made for a patent which, in the opinion of the Examiner, would interfere with any pending application, or with any unexpired patent, an interference may be declared The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability.

35 U.S.C. § 135(a) (2000) (emphasis added). The plain meaning of this statute demonstrates that Congress has expressly indicated its preference that the declaration of an interference pursuant to § 135 be discretionary. Barton v. Adang, 162 F.3d 1140, 1144 (Fed. Cir. 1998) ("The plain meaning of this statute is clear from the use of the permissive term 'may' that the [Examiner] has discretion whether to declare an interference."). However, Section 135(a) states that the Board shall determine questions of priority once an interference proceeding is declared. This authority for the Board to determine questions of priority does not vitiate the Examiner's discretion to begin or discontinue an interference once declared. See 35 U.S.C. § 135(a).

Accordingly, the mandatory language instructs the Board of its jurisdiction over an active interference and the Examiner over the discretionary declaration of an interference.

37 C.F.R. ~ 1.601(n)

The Appellant concedes that 35 U.S.C. § 135(a) permits some discretion. However, the Appellant also argues that the Examiner's discretion under 35 U.S.C. § 135(a) is bridled by statutory mandate that requires issuance of only one patent to the first inventor. See 35 U.S.C. § 102(g) (2000). Specifically, the Appellant argues that the proper test for whether two claims are the same patentable invention is a "one-way" test, i.e., the claimed invention of Party A is the same patentable invention as the claimed invention of Party B when the claimed invention of Party A anticipates or renders obvious the claimed invention of Party B, or the claimed invention of Party B anticipates or renders obvious the claimed invention of Party A.

The Appellant submits that the Examiner improperly rejected the Appellant's arguments. Under regulations promulgated by the Examiner, an interference proceeding is declared when two parties

are claiming the "same patentable invention." 37 C.F.R.

§ 1.601(i).

According to the regulations, an "interference-in-fact" exists only if both parties to an interference have at least one claim that defines the "same patentable invention." Id.~ 1.601(j). The phrase "same patentable invention" is defined as follows:

Invention "A" is the same patentable invention as an invention "B" when invention "A" is the same as (35 U.S.C. [~] 102) or is obvious (35 U.S.C. [~] 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A." Invention "A" is a separate patentable invention with respect to invention "B" when invention "A" is new (35 U.S.C. [~] 102) and non-obvious (35 U.S.C. [~] 103) in view of invention "B" assuming invention "B", is prior art with respect to invention "A." Id. § 1.601(n).

The first sentence of § 1.601(n) states that "same patentable invention" means that the invention of one party anticipates or renders obvious the other party's invention. Section 1.601(n) also defines "separate patentable invention" to mean that the invention of one party is new and nonobvious in view of the other party's invention.

**Claims 48. 49. 51., 58 and 59 Are Materially the Same Scope
As the Patented Claims such that the Interference Doctrine
Applies**

"A count defines the interfering subject matter between two or more applications or between one or more applications and one or more patents." 37 C.F.R. § 1.601(f). Typically, the Examiner determines which claims correspond to the count in order to determine the subject matter of the interference. ~ ("Any claim of an application or patent that is designated to correspond to a count is a claim involved in the interference.) id. § 1.603.

In determining whether it is proper to designate an application or patent claim to correspond to a count, the pertinent inquiry is whether that "claim defines the same patentable invention as another claim whose designation as corresponding to the count the moving party does not dispute." Id. § 1.637(c)(3)(ii). In that regard, what constitutes the "same patentable invention" is defined by 37 C.F.R. § 1.601(n), which was formulated to determine the extent of interfering subject matter as between applications (or a patent application and an issued patent) of potentially conflicting parties. See In re Van Geuns, 988 F.2d 1181, 1185 (Fed. Cir. 1993).

First, the Examiner acknowledges that claims 48, 49, 51 and 58 and 59 are exact copies of claims 20, 21, 23 and 30 and 31 of the U.S. patent number 6,550,226 to Gates et al. Accordingly, claims identical in scope cannot be in issue and the only contention raised by the Examiner relates to the alleged lack of support for the claims.

With respect to the claim construction of claim 48 of the patent application proposed by the Appellant the following analysis will be of assistance. The underlined text indicates those elements deemed contentious by the Examiner as allegedly lacking support by the Appellant's disclosure.

Claim 48/Claim 20	Present Figure (Y/N)	Element
providing an empty and collapsed bag on a bag holder	Y	1/1, 24-23 46/14
opening the bag;	Y	7(b) 6-1114-21 46/14
filling the bag;	Y	7(c), (d) 46/64 & 67
<u>grasping opposed top edges of the bag with grabber arms;</u>	Y	7(i) 46/64 & 67
<u>pulling the top edges apart;</u>	Y	7(b) 46/67
delivering the bag to a sealing apparatus <u>including the "finger assemblies"</u>	Y	7(i) 50
<u>that move up, over and down over the top edges of the bag;</u>	Y	2-3, 7(a)-(i) 46/64 & 67
	Y	7(c)-(f) 50
		46
<u>sealing the bag</u>	Y	not shown 120

Clearly, as shown in the above Table in comparison to Gates et al., all of the elements of claim 48 are covered in the description of Appellant's present invention and parallel all of the elements of the Gates et al. claims.

More specifically, Figure 17 of U.S. 6,550,226, Gates et al. specifies that the bag 14 is clampingly engaged by fingers (128,134,132) on the grabber 114. Column 7, lines 24-42 clearly describes the grabber arms as movable upwardly, outwardly and downwardly, while lines 43-57, describe the finger assemblies as pivotable to grasp the top edges of the bag. Thus, within the context of the claim as set out in Gates et al., the present invention functions similarly to Gates et al.

The Examiner's assertion that the specification does not disclose a step of "moving the finger assemblies up, over and down over the top edges of the bag" with the step of delivering the bag to the sealing apparatus is inconsistent with the position that the Gates reference has taken - namely, that the arm assemblies move the finger assemblies resulting in the simultaneous movement of both elements. Even with a very narrow interpretation of the claim, the finger assemblies of Gates et al. also do not move up, over and down over the top edges of the bag but rather the grabber assemblies mounted on each arm are movable upwardly, overly and downwardly whereby the finger assemblies can only grasp the bag. This is similar to the disclosure of the present invention on page 12, lines 7-10 and

lines 23-28, of the description and is illustrated in Figures 7(d)-(i). Thus, the Examiner's interpretation has no support.

The Examiner goes on to state that the gripper assembly of the present invention only retracts laterally, seen in Figure 7(i) to transfer the bag 46 longitudinally to the conveyor station 54. Again, as outlined on page 12 of the present application, lines 23-28, it is disclosed that "Lateral reciprocating movement of the gripper assembly 50 relative to the carriage 52 is achieved by means of slidable movement of the beam 96 within the second sleeve 94, which in turn is driven by a pneumatic cylinder 98 linking the respective members. Vertical movement of the gripper assembly 50 is achieved by operation of the pneumatic cylinder 92". At page 13, line 26, the disclosure also reads as follows: ". . .As the hopper is discharging the commodity, the bag gripper assembly 50 advances laterally towards the hopper 28, seen in Figures 7(c)-(e), and subsequently downwardly, as seen in Figure 7(f), ...". It is clear that the gripper assembly cannot possibly advance laterally and subsequently downwardly on a continuous basis and that at some point upward movement must be completed during the cycle. It would be clear to a person skilled in the art that the bag gripper assembly would in fact advance laterally towards the hopper 28 subsequently **downwardly**, such that the fingers of both the inner and the outer arms of the gripper assembly grasp the bag 46, laterally withdraw the bag from the area below the hopper before transferring the bag to the conveyor station and subsequently moving upwardly into position for the next commodity filled bag.

In light of the above, it is clear that all of the elements of claim 48 that were identified by the Examiner as not being disclosed by the present invention are in fact disclosed. Accordingly, claim 48 meets the one-way test and should be identified as the first count.

Turning now to claims 49 and 59, the Examiner's position is that the step of "moving finger assemblies away from each other" does not occur because the finger assemblies of the present invention are fixedly mounted to the gripper assembly. While this statement is true with respect to the outer arms, the inner arms are in fact movable relative to the outer arms of the gripper assembly 50. The movement of the inner arms relative to the outer arms is clearly shown in Figures 2 and 3 and also in Figures 7(a) and (b). Finger assemblies 64 and 67 are described on page 11, lines 26 to 31 which states that "the inner arm 66 are each connected to a corresponding pneumatic cylinder 70 mounted to the base 60, with the cylinders adapted to drive the inner arm 66 between reciprocating converging and diverging port positions. The inner arm 66 reciprocates between a converged first position, shown in Figure 7(a), wherein the finger 67 of the inner arm 66 are spaced substantially apart from the finger 64 of the fixed outer arm 62, and the second diverged position shown in Figure 7(b), wherein the respective fingers 64 and 67 of the inner and outer arms meet to clampingly engage a bag 46 therebetween". Understandably, in order for inner and outer fingers 67, 64 to converge and diverge, the fingers would require the movement of the inner arm fingers to move towards and away from each other. Accordingly, the step of moving finger assemblies away from each

other to close the opening of the bag does occur in the present invention and counts with respect to both claims 49 and 59 meet the one-way test for the declaration of an interference.

With respect to the Examiner's position regarding claim 51, namely that the bag 46 is not grasped and pulled by the gripper arms 62 and 66 while the transferring step is conducted, it is clear that the present application discusses drawing the bag taut before moving the bag to the sealing station. More specifically, page 14, lines 1-3, specifically describe gripping the opposed corners of the bag between the respective inner and outer fingers 64 and 67 and identify Figures 7(h) and Figure(i). Even if it were argued that claim 51 intends to specify that the pulling of the grasped top edges of the bag apart occurs simultaneously while delivering the bag to the sealing apparatus there is not, in fact, a statement to the effect that the "pulling" is a specific movement occurring simultaneously. Rather, the claim broadly states that the top edges of the bag are pulled apart, e.g. pulled taut, which is clearly taught in the present application and the subject matter of claim 51 is clearly found to be supported by the present invention and thus a count to establish the declaration of an interference.

With respect to claim 58, the Examiner states that the Appellant teaches at page 11, lines 14-31, that the finger assemblies are fixedly mounted to the gripper assembly and therefore they do not "move inwardly and down to grasp the top

edges of the bag". However, similarly to claim 48, it is again pointed out that the finger assemblies identified in Gates et al. also do not move "inwardly and down to grasp the top edges of the bag" within the context the Examiner implies. Column 7, lines 44 to 57, of the U.S. 6,500,226 reference discuss that the finger assemblies are simply pivotable and would not in fact be movable both "inwardly and down" without the assistance of the grabber assembly. Even if it were argued that the claim language intended to specify that the finger assemblies moved inwardly with respect to the bag, the argument would simply support the Appellant's position that the finger assemblies of the Droog et al. application would also move inwardly with the assistance of the gripper assembly 50. However, the finger assemblies do not in fact move laterally with respect to the top edges of the bag in Gates et al. Thus, the Appellant has again shown that, in the context of the teachings of Gates et al. the Appellant's previously presented claim 58 also falls within the scope of the Appellant's described invention.

Accordingly, the Appellant believes it clearly shown that the Examiner erred in failing to declare an interference-in-fact based on at least five (5) counts of interfering subject matter.

The Priority Date is Properly Claimed

The present application is a divisional application and claims priority under U.S.C. Section 120 of the PCT/CA00/001 14,

filed February 7, 2000 and also under U.S.C. Section 119 of Canadian Patent Application Number 2,262,276, filed February 15, 1999.

The second argument submitted by the Examiner is that 35 U.S.C. 102 forms the basis of a rejection for claims 48, 49, 51, 58 and 59 of the present application as being anticipated in view of Gates et al. The Examiner states that the subject matter of the claims forms new subject matter and as such the claims are not entitled to the filing date of the parent application. However, the Appellant has clearly shown herein above that there is significant detailed support for each element of the rejected claims in the Appellant's specification. Moreover, the Examiner, having determined that the inventions are separate and distinct cannot ignore the plain meaning of the statute in order to serve the Examiner's opinion for rejection of the claims. Accordingly, the merits of the Examiner's rejection of the subject matter of claims 48, 49, 51, 58 and 59 under 35 U.S.C. 102 has no factual basis.

That the Examiner failed definitively to construe claims 48, 49, 51, 58 and 59 of the patent application is plain enough. In

addition, the Examiner erred in this case because the Examiner did not apply the one-way test to find that, whether construed broadly or narrowly, the claims of the patent application defines the same patentable invention as the corresponding claims 20, 21, 23 and 30 and 31 of issued U.S. Patent Number 6,550,226, Gates et al., which are in dispute.

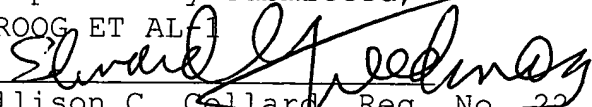
In view of the fact that the Examiner failed to apply the appropriate tests to any of the Gates et al. claims from the Appellant's claims for interfering subject matter, the Examiner erred in his determination by failing to declare an interference-in-fact. Further, it was necessary for the Examiner to specify that the claims proffered by the Appellant as lacking a priority claim to establish rejection of the claims. Accordingly, the Examiner failed to recognize that there was indeed an interference-in-fact.

IX. Conclusion

In summary, an Interference-in-fact was clearly established and finds particular application to these factual circumstances; i.e., enabling appellant to obtain patent coverage consistent with the original disclosure. The Examiner's Final Rejection based on 35 USC 112 is without legal or factual basis, given the fact that the limitations upon which the Examiner focuses as not being supported

limitations upon which the Examiner focuses as not being supported in the original disclosure clearly are found supported. The Final Rejection of the Examiner is accordingly improper and should be reversed by the Honorable Board.

Respectfully submitted,
DROOG ET AL-1


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Enclosure: 1. Check in the amount of \$250 (filing of Appeal
Brief-Small Entity)
2. Appendix-Claims on Appeal

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner of Patents, Alexandria, VA 22313-1450, on June 9, 2005.



Maria Guastella

APPENDIX A

CLAIMS ON APPEAL

Claim 48..

A method of filling a bag with a material and sealing a bag;
the method comprising the steps of:

- (a) providing an empty collapsed bag on a bag holder;
- (b) opening the bag;
- (c) filling the bag with material;
- (d) grasping the opposed top edges of the bag with a pair of grabber arms;
- (e) pulling the grasped top edges of the bag apart;
- (f) delivering the bag to a sealing apparatus; and
- (g) sealing the bag,

wherein step (f) includes the steps of providing a pair of finger assemblies and
moving the finger assemblies up, over, and down over the top edges of the bag.

Claim 49.

A method of claim 48, further comprising the step of moving
finger assemblies away from each other to close the opening
of the bag.

Claim 51.

The method of claim 48, wherein step (e) is being conducted
while step (1) is being conducted.

Claim 58.

A method of filling a bag with a material and sealing a bag;
the method comprising the steps of:

- (a) providing an empty collapsed bag on a bag holder;
- (b) filling the bag with material;
- (c) grasping the opposed top edges of the bag with a

pair of finger assemblies that move inwardly and down to grasp the top edges of the bag, the motion being with respect to the bag;
(d) delivering the bag to a sealing apparatus; and
(e) sealing the bag.

Claim 59. The method of claim 58, further comprising the step of moving finger assemblies away from each other to close the opening of the bag.